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PATENT
Attorney Docket No. 05905.0179

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Yusuke SHIMIZU et al.) Group Art Unit: 3714
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Application No.: 10/517,443) Examiner: A. Epshteyn
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Filed: December 9, 2004) Confirmation No.: 8650
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For: GAME MACHINE)
)
)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Reply to Office Action

In reply to the Office Action mailed April 3, 2007, the period for response extending to July 3, 2007, Applicants request reconsideration of the application in view of the remarks below.

Claims 11, 12, and 16-22 remain pending and under current examination¹.

In the Office Action² mailed April 3, 2007 (hereinafter, "Office Action"), the Examiner rejected claims 18 and 20-22 under 35 U.S.C. § 102(e) as being anticipated by Benoy et al. (U.S. Patent No. 6,896,618) (hereinafter, "Benoy"); rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Benoy; rejected claims 11, 16,

¹ In the Office Action, claims 11, 12, and 15-22 are listed as pending and rejected on the Summary page. However, claim 15 was canceled in the last Amendment that was entered with the filing of the Request for Continued Examination on December 27, 2006.

and 17³ under 35 U.S.C. § 103(a) as being unpatentable over Benoy in view of Hedges et al. (U.S. Patent No. 4,339,798) (hereinafter, "Hedges"); and rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Benoy in view of Hedges and further in view of Beach et al. (U.S. Patent No. 6,116,402) (hereinafter, "Beach").

Applicants respectfully traverse the rejections for the following reasons and request allowance of claims 11, 12, and 16-22.

I. Rejection of Claims 18 and 20-22 Under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejections of claims 18 and 20-22 under 35 U.S.C. § 102(e) as being anticipated by Benoy. A proper anticipation rejection requires each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference. See M.P.E.P. § 2131, 8th Ed., Rev. 5 (August 2006). The anticipation rejection set forth in the Office Action does not properly establish that each and every element of the claims is found in Benoy.

Regarding claim 18, Benoy does not disclose each and every element of Applicants' invention. Benoy appears to disclose a loyalty program registration method wherein the player enters personal identification information at a game machine. See Benoy, Abstract. This information is sent to a player tracking server along with a

(...continued)

² The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

³ In the Office Action near the bottom of page 5, the Examiner states that claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Benoy and Hedges. However, the detailed discussion of the rejection is instead directed to the rejection of claims 11, 16, and 17 as unpatentable over Benoy and Hedges. Therefore, Applicants assume that the Examiner intended to indicate claims 11, 16 and 17 instead of claim 19 near the bottom of page 5.

registration request, whereupon the player tracking server confirms the registration.

See Id.

While Benoy appears to disclose the loyalty program registration method, Benoy fails to teach or suggest Applicants' claimed **terminal device** comprising "**operation means** with which a player inputs a character message and identification information for identifying a player" and "**communication means** for transmitting the character message and the identification information to the server device," as recited in claim 18 (emphasis added). Further, Benoy fails to teach or suggest Applicants' claimed **server device** comprising "**data management means** for registering the character message and the identification information transmitted from the terminal device in association with each other in a database, and searching the database based on the identification information received from the arcade game machine," and "**communication means** for transmitting a character message associated with the identification information specified by the search conducted by the data management means to the arcade game machine," as also recited in claim 18 (emphasis added).

The Office Action alleges that Benoy teaches "[t]he player tracking unit on the game machine comprises a terminal device in which a player inputs a character message and identification information for identifying a player (10: 60-68)." See Office Action, page 2. However, this appears to mischaracterize Benoy.

The cited text of Benoy discloses that "the player tracking unit 56" "may optionally display a message requesting the game player to validate their identity by **entering an identification code** using a game service interface with an alpha-numeric key pad displayed on touch screen display 16." See Benoy, column 10, lines 61-67 (emphasis

added). While Benoy does disclose entering an “identification code,” Benoy’s “identification code” does not teach the claimed “character message,” as required by claim 18 for the reasons below.

Among other limitations, claim 18 recites:

“the terminal device comprising:
operation means with which a player **inputs a character message** and identification information for identifying a player; and
communication means for **transmitting the character message** and the identification information to the server device,

the arcade game machine comprising:
reading means for reading, via an interface, identification information for identifying a player recorded on an external memory medium; and
communication means for transmitting the identification information read by the reading means to the server device, and

the server device comprising:
data management means for **registering the character message** and the identification information transmitted from the terminal device in association with each other in a database, and searching the database based on the identification information received from the arcade game machine; and
communication means for **transmitting a character message** associated with the identification information specified by the search conducted by the data management means to the arcade game machine.” (emphasis added)

According to the recitations of claim 18, the claimed “character message” is input by a player **at a terminal device** that is distinct from “an arcade game machine installed in a play facility with which a player plays a game after paying a play fee.” In contrast to the claimed “character message,” Benoy’s “identification code” is entered **at a player tracking unit 56** which is mounted within a main cabinet 8 of **a gaming machine 92 of casino 150**. See Benoy, column 8, lines 55-57. Therefore, Benoy fails to teach entering the “identification code” **at the terminal device**, as required by claim 18.

Rather, Benoy appears to teach entering the “identification code” **at an arcade game machine** “installed in a play facility with which a player plays a game after paying a play fee.” Furthermore, according to the recitations of claim 18, the claimed “character message” is, at a server device, registered in association with the identification information in a database and **transmitted to an arcade game machine, when associated with an identification information specified by a search.** While Benoy discloses the “identification code,” Benoy does not teach that the “identification code” sent to the player tracking server 62, **is transmitted to the gaming machine 92** by the player tracking server 62, **when associated with an identification information specified by a search**, as would, at very least be required to anticipate claim 18.

In addition, while the Office Action alleges that Benoy teaches “[t]he server device comprises data management means for registering the character message... and communication means for transmitting a character message associated with the identification information specified by the search to identify the player (16: 46-67 to 17: 1-5)” (Office Action, pages 2-3), this appears to mischaracterize Benoy.

The cited text of Benoy discloses that “[a]fter the player has **entered** the required information using the game service interface,” “a registration request message is **sent** to the player tracking server.” See Benoy, column 16, lines 46-49 (emphasis added). Further, the cited text of Benoy discloses that “[t]he registration request message contains the information necessary to register the player to the loyalty program such as the identification information **entered** by the player and identification information from the loyalty point instrument used in the registration process.” See Benoy, column 16, lines 49-53 (emphasis added). Again, while Benoy disclose an “identification code,”

Rather, Benoy appears to teach entering the “identification code” **at an arcade game machine** “installed in a play facility with which a player plays a game after paying a play fee.” Furthermore, according to the recitations of claim 18, the claimed “character message” is, at a server device, registered in association with the identification information in a database and **transmitted to an arcade game machine, when associated with an identification information specified by a search.** While Benoy discloses the “identification code,” Benoy does not teach that the “identification code” sent to the player tracking server 62, **is transmitted to the gaming machine 92** by the player tracking server 62, **when associated with an identification information specified by a search**, as would, at very least, be required to anticipate claim 18.

In addition, while the Office Action alleges that Benoy teaches “[t]he server device comprises data management means for registering the character message... and communication means for transmitting a character message associated with the identification information specified by the search to identify the player (16: 46-67 to 17: 1-5)” (Office Action, pages 2-3), this appears to mischaracterize Benoy.

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Benoy's "identification code" does not teach the claimed "character message," for the above reasons. Nowhere in the cited portion of Benoy is there a teaching of inputting the "identification code" **at a terminal device**, and **transmitting** the "identification code," "associated with the identification information specified by the search to identify the player", as required by claim 18.

For at least the above reasons, Benoy fails to disclose each and every element of Applicants' claim 18. Accordingly, the Examiner should withdraw the rejection of claim 18 under 35 U.S.C. § 102(e). The Examiner should also withdraw the rejection of claims 20 and 21 under 35 U.S.C. § 102(e) at least due to their dependence from claim 18.

Independent claim 22, although of different scope, recites limitations corresponding to limitations of claim 18 discussed above. Therefore, claim 22 is also allowable over Benoy for at least the reasons set forth above regarding claim 18.

II. Rejection of Claims 19, 11, 16, 17, and 12 Under 35 U.S.C. 103(a)

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2. In this application, a *prima facie* case of obviousness has not been established for at

least the reason that the prior art fails to teach or suggest each and every element of the claims 19, 11, 16, 17, and 12.

Applicants respectfully traverse the rejection of claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Benoy. Claim 19 depends from claim 18 and, thus, requires each and every element of claim 18. As stated above, Benoy fails to teach or suggest several features of claim 18 including Applicants' claimed "character message" input by a player at a terminal device. Therefore, at least due to its dependence from claim 18, Benoy fails to teach or suggest every feature of Applicants' claim 19.

Further, the Office Action asserts that "[i]f the result of the player's game play is a preset special game result, such as well known in the art, invoking a special prize as Benoy teaches (11:23-48), it is obvious to one skilled in the art that display means can display information received in the character message such as player identification in the awarding of the prize or the prize redemption characteristics." See Office Action, page 5. However, this appears to mischaracterize Benoy. While the cited portion of Benoy appears to disclose providing additional special services, such as redeeming a prize or making a reservation by using a touch screen display 16 (column 11, lines 22-31), the cited portion of Benoy does not teach **displaying the personal identification information on the touch screen display 16**. Therefore, Benoy fails to teach or suggest Applicants' claimed arcade game machine "wherein the game processing means...makes the display means display the received character message if the result of a player's game play is a preset special game result," as recited in claim 19.

Applicants respectfully traverse the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Benoy in view of Hedges. Neither Benoy, nor

Hedges, nor the combination thereof, establish a *prima facie* case of obviousness as required under 35 U.S.C. § 103(a). Benoy and Hedges, taken alone or in combination, do not teach or suggest every feature of Applicants' claim 11. For example, Benoy and Hedges do not teach or suggest, at least, Applicants' claimed game system comprising "ID generating means for generating an ID for uniquely identifying an external memory medium," "means for generating an access code corresponding to the ID and visually identifiable to a game player," and "data management means for managing the ID and the access code in association with one another," as recited in claim 11.

Regarding claim 11, the Office Action alleges that Benoy teaches "an ID generating means for generating an ID for uniquely identifying an external memory medium attached to the external medium (3: 3-8[])." However, this appears to be a mischaracterization of Benoy. See Office Action, pages 5-6. Benoy teaches a loyalty program instrument, such as a magnetic striped card, having a serial number or other identifying information. See Benoy, column 3, lines 3-10. Benoy discloses the information identifying the loyalty program instrument as "**obtained** from the loyalty program instrument such as the serial number from the magnetic striped card." See Benoy at column 32, lines 39-40 (emphasis added). While Benoy does disclose **obtaining** information identifying the loyalty program instrument, Benoy does not teach or suggest **generating** the information identifying the loyalty program instrument. Therefore, Benoy fails to teach or suggest an "ID generating means for generating an ID for uniquely identifying an external memory medium," as recited in claim 11. Nor does Benoy teach or suggest an "ID recording means for recording the generated ID in a

magnetic data recording area provided in the external memory medium,” as also recited in claim 11.

Further, the Office Action states, “[t]he gaming system further includes means for generating an access code corresponding to the ID (16:10-45), where the access code corresponds to a signature or biometric information of the player and is visually identifiable to the game player.” See, Office Action, page 6. Applicants respectfully disagree with this characterization. The cited portion of Benoy states, “[t]he player’s signature may be recorded and stored so that it may be later used for identification purpose.” See, Benoy, column 16, lines 12-14. Further, the cited portion of Benoy states, “[b]esides a signature, other biometric information may be recorded from the players as part of the registration process.” See, Benoy, column 16, lines 27-28.

While Benoy does disclose **recording** a player’s signature or other biometric information, Benoy does not teach or suggest **generating** a player’s signature or other biometric information which **corresponds to “the ID”**. The Office Action fails to address the referenced claim limitation in its entirety. That is, claim 11 recites, “means for generating an access code **corresponding to the ID**” (emphasis added) which is **generated** “for uniquely identifying an external memory medium attached to the external interface,” as required by claim 11. As noted above, because Benoy fails to teach or suggest Applicants’ claimed ID generating means for generating an ID for uniquely identifying an external memory medium, Benoy cannot teach or suggest Applicants’ claimed means for generating an access code **corresponding to the ID** and visually identifiable to a player.

Additionally, the Office Action asserts “[i]t would be obvious to one skilled in the art that such access code information such as a photo ID or a signature of the game player could be printed on the external memory medium to further identify the player after the access code is generated.” See, Office Action, page 6. Applicants respectfully disagree. While Benoy does disclose **recording** a signature or other biometric information, nowhere in Benoy is there a teaching or suggestion of **printing** the signature and other biometric information “in a printing area of” a loyalty program instrument. The Examiner’s assertion is speculative at best, and Applicants request that he cite a reference supporting his assertion and rejection.

Furthermore, the Office Action at page 6 asserts that “Hedges teaches of a gaming system that establishes player accounts for a credit system (8: 7-29). In the system of Hedges, an identification number is established for a player which is then recorded on a magnetic card.” However, Hedges fails to cure the deficiencies of Benoy. The cited portion of Hedges discloses that a disclosed credit station 9 : “1. Issues credit cards to users.” See Hedges, column 8, line 10. While Hedges does teach or suggest issuing credit cards **by the credit station 9** (column 8, lines 8-10), Hedges does not teach or suggest generating an ID for uniquely identifying an external memory medium attached to an external interface of a game machine **by a game machine**. Further, Hedges’s teaching of issuing credit cards fails to teach Applicants’ claimed “means for generating an access code corresponding to the ID...,” “printing means for printing the access code...,” and “data management means for managing an ID and an access code in association with one another...,” as recited in claim 11. Therefore, Hedges does not cure the deficiencies of Benoy set forth above, including the failure of Benoy to

teach or suggest, at least, Applicants' claimed means for generating an access code, and data management means for managing the ID and the access code in association with one another.

For at least the above reasons, Benoy and Hedges, taken alone or in combination, fail to teach or suggest every feature of Applicants' claim 11. Accordingly, the Examiner has not met the burden of establishing a *prima facie* case of obviousness of claim 11 over Benoy and Hedges. Therefore, the Examiner should withdraw the rejection of claim 11 under 35 U.S.C. § 103(a). The Examiner should also withdraw the rejection of claims 16-17 at least due to their dependence from claim 11.

Applicants traverse the Examiner's rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Benoy in view of Hedges and further in view of Beach. Beach appears to disclose a system which assists in detecting alteration of value documents or transmissions, such as a coin counter voucher. (Abstract) More particularly, Beach appears to teach a system and method for detecting voucher counterfeiting, alteration, duplication, fabrication, and the like by including encoded or encrypted voucher information. See Beach, column 9, lines 34-39.

However, Beach does not cure the deficiencies of Benoy and Hedges set forth above and the failure of Benoy and Hedges to teach or suggest a system comprising, at least, "means for generating an access code...," and "data management means for...," as recited in independent claim 11, from which claim 12 depends.

The Office Action, at page 8, asserts that "Beach, however, teaches of a system that encodes vouchers that are in the form of magnetic cards with time and machine location information" and alleges that this cures the deficiencies of Benoy and Hedges.

However, this is not the case. Beach teaches an encryption method wherein the time and machine location are part of the encryption scheme. See Beach, column 8, line 66 through column 9, line 32. Beach does not teach or suggest generating an access code, nor does Beach teach or suggest a data management means for managing an ID and an access code in association with one another, authenticating the game player in accordance with the access code, and upon authentication of the game player, providing the game player with a network service, as required by claim 11.

In addition, the Office Action asserts, at page 8, that it would have been obvious to one skilled in the art to “allow the tracking of timing as Benoy teaches to be used to define the serial numbers used to encode the player identification cards.” This appears to mischaracterize the teachings of Benoy. First, Benoy does not teach or suggest encoding as the Office Action asserts. Second, the “tracking of timing,” which the Office Action states “[may be] used to define the serial numbers,” is speculative at best. As stated above, Benoy discloses that the serial number are obtained **from** the cards. In addition, the cited passage of Benoy clearly states that “the player tracking unit 56 may poll ... for game play information such as ... the time when each game was initiated ... [and] the player tracking server 62 may use the game play information ... to generate player tracking points....” See, Benoy column 11, lines 8-17. Nowhere does Benoy teach or suggest that there is “tracking of timing” or that timing information is used “to define serial numbers,” as the Office Action asserts. See Office Action, page 8. Therefore, it would not have been obvious to use the encoding taught by Beach in the system and method disclosed by Benoy.

For at least the reasons stated above, Applicants submit that neither Benoy, Hedges, nor Beach, nor any combination thereof, teach or suggest all the elements of Applicants' claim 12. Thus, Applicants respectfully request allowance of claim 12.

III. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of claims 11, 12, and 16-22. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 

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Dated: July 3, 2006